

**REMARKS:**

Claims 1-34 are currently pending in the application. Claims 1-34 stand rejected under 35 U.S.C. § 103(a) over Chipman (U.S. Patent No. 6,038,668) in view of Hokanson (U.S. Patent No. 6,094,680).

This Amendment amends claims 1, 17, 33, and 34 in order to more particularly point out and distinctly claim the present invention. No new matter has been added. Applicants expressly reserve the right to pursue broader claims and/or to appeal any or all rejections.

**Claim Rejection under 35 U.S.C. § 103(a):**

Claims 1-34 stand rejected under 35 U.S.C. § 103(a) over Chipman (U.S. Patent No. 6,038,668) in view of Hokanson (U.S. Patent No. 6,094,680). However, because the proposed combination of Chipman and Hokanson fails to disclose or suggest all of the limitations of claims 1-34 as currently amended, it is respectfully submitted that the proposed combination of Chipman and Hokanson cannot render these claims obvious.

With respect to independent claim 1 (as well as claims 2-16, which depend from claim 1), this claim relates to a method for migrating data within an electronic commerce system comprising monitoring requests for product data by users. Claim 1 is amended herein to include "*generating a request history for each of the users based on the monitoring of the requests for product data by the users*" and "*determining, in response to monitoring requests for product data by the particular user using the request history for the particular user, that the product data requested by the particular user should be migrated ....*"

Chipman discloses a networked catalog search, retrieval, and information correlation and matching system, which allows suppliers to publish information in electronic catalogs and structure the information in an object oriented representation distributed across a network of computers. Hokanson discloses a network, multiple network sites (e.g., Internet Service Providers) for facilitating user access to the network, and a network manager. The network is disclosed in Hokanson primarily as being

distributed software modules resident in the servers of the network sites, as opposed to a centrally located computing device that manages the entire network. However, Chipman and Hokanson, whether considered separately or in combination, fail to disclose or suggest “*generating a request history for each of the users based on the monitoring of the requests for product data by the users*” and “*determining, in response to monitoring requests for product data by the particular user using the request history for the particular user, that the product data requested by the particular user should be migrated*” as recited by amended claim 1. Thus, the proposed combination of Chipman and Hokanson fails to disclose or suggest all of the limitations of claim 1 as amended and, accordingly, cannot render obvious amended claim 1, or claims 2-16 depending from claim 1.

With respect to independent claims 17, 33, and 34, these claims have been amended in a manner similar to claim 1. Therefore, claims 17 (as well as claims 18-32 depending from claim 17), 33, and 34 are considered patentably distinguishable over the proposed combination of Chipman and Hokanson for at least the reasons discussed above in connection with claim 1.

For the reasons set forth herein, the Applicants submit that claims 1-34 are not rendered obvious by the proposed combination of Chipman and Hokanson. The Applicants further submit that claims 1-34 are in condition for allowance. Therefore, the Applicants respectfully request that the rejection of claims 1-34 be reconsidered and claims 1-34 be allowed.

**The Legal Standard for Obviousness Rejections Under 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Extension for Response Within the Second Month and authorization for charging its fee to Deposit Account No. **500777** is submitted herewith. The undersigned hereby authorizes the Commissioner to charge any additional fees that may be required, or credit any overpayments, to Deposit Account No. **500777**. If the extension of time is missing or is insufficient for enabling this document to be timely, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed. Any fee required for such Petition for Extension of Time should be charged to Deposit Account No. **500777**.

**Please link this application to Customer No. 38441 so that its status may be checked via the PAIR System.**

Respectfully submitted,

11 APRIL 2005  
Date



James E. Walton, Registration No. 47,245  
Daren C. Davis, Registration No. 38,425  
Brian E. Harris, Registration No. 48,383  
Michael Alford, Registration No. 48,707  
Law Offices of James E. Walton, P.L.L.C.  
1169 N. Burleson Blvd., Suite 107-328  
Burleson, Texas 76028  
(817) 447-9955 (voice)  
(817) 447-9954 (facsimile)  
jim@waltonpllc.com (e-mail)

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